REMARKS

Claims 1-20 were pending in this application.

Claims 1-4 and 6-20 have been rejected.

Claim 5 has been objected to.

Claims 1-20 have been amended as shown above.

Claims 21 and 22 have been added.

Claims 1-22 are now pending in this application.

Reconsideration and full allowance of Claims 1-22 are respectfully requested.

I. ALLOWABLE CLAIMS

The Applicants thank the Examiner for the indication that Claim 5 would be allowable if rewritten in independent form to include the elements of its base claim and any intervening claims. The Applicants have rewritten Claim 5 in independent form. The Applicants respectfully submit that Claim 5 is allowable. The Applicants respectfully request full allowance of Claim 5.

II. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1-4, 6-8, and 11-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,275,531 to Li ("*Li*") in view of U.S. Patent No. 6,075,768 to Mishra ("*Mishra*"). The Office Action rejects Claims 9 and 10 under 35 U.S.C. § 103(a) as being unpatentable over *Li* and *Mishra* in further view of U.S. Patent No. 5,742,892 to Chaddha

("*Chaddha*"). These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP § 2142; In re Fritch, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)*). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP § 2142; In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)*). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (*MPEP § 2142; In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)*). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Grabiak, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)*).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)*). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or

suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (*MPEP § 2142*).

Li recites a video encoding method and apparatus for adapting a video stream to the bandwidth of a transmission channel in a network. (*Abstract*). In particular, a video encoder encodes a video stream as a base layer bitstream and *N* enhancement layer bitstreams. (*Col. 3, Lines 44-58*). A video decoder may be capable of receiving and decoding the base layer bitstream and *M* enhancement layer bitstreams, where $M \leq N$. (*Col. 3, Lines 28-43; Col. 3, Line 59 – Col. 4, Line 3*).

The cited portions of *Li* simply recite that video data may be encoded as *N* enhancement layer bitstreams. The cited portions of *Li* also simply recite that fewer than *N* enhancement layer bitstreams may be decoded. The cited portions of *Li* lack any mention of reducing the size of any of the enhancement layer bitstreams. The cited portions of *Li* also lack any mention of transmitting an enhancement layer bitstream that has been reduced in size.

Because of this, *Li* fails to disclose, teach, or suggest selecting a "number of enhancement layer frames," reducing a "size of the selected number of enhancement layer frames," and transmitting "at least a portion of at least one of the enhancement layer frames" where the "at least one transmitted enhancement layer frame [has] been reduced in size" as recited in Claims 1, 7, and 11. *Li* also fails to disclose, teach, or suggest selecting a "number of enhancement layer frames," calculating a "reduced size of the selected number of enhancement layer frames," and transmitting "at least a portion of at least one of the enhancement layer frames" where the "at least one

transmitted enhancement layer frame [has] been reduced in size" as recited in Claims 9 and 10.

Mishra is cited by the Office Action only as allegedly disclosing the step of determining a loss of bandwidth. *Mishra* is not cited by the Office Action as disclosing, teaching, or suggesting these elements of Claims 1, 7, and 9-11. Also, *Chaddha* is cited by the Office Action only as allegedly disclosing the use of a memory medium including code for streaming scalable video. *Chaddha* is not cited by the Office Action as disclosing, teaching, or suggesting these elements of Claims 1, 7, and 9-11.

For these reasons, the Office Action has not established that the proposed *Li-Mishra* combination or the proposed *Li-Mishra-Chaddha* combination discloses, teaches, or suggests all elements of Claims 1, 7, and 9-11. As a result, the Office Action has not established a *prima facie* case of obviousness against Claims 1, 7, and 9-11 (and their dependent claims).

Accordingly, the Applicants respectfully request withdrawal of the § 103 rejection and full allowance of Claims 1-4 and 6-20.

III. NEW CLAIMS

The Applicants have added new Claims 21 and 22. The Applicants respectfully submit that no new matter has been added. The Applicants respectfully request entry and full allowance of Claims 21 and 22.

IV. CONCLUSION

For these reasons, the Applicants respectfully submit that all pending claims in this application are allowable and respectfully request full allowance of all pending claims.

SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Applicants have included the appropriate fee to cover the cost of this AMENDMENT AND RESPONSE. The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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Date: Sept 15, 2004

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